

Appl. Scr. No.10/729,142
Amdt. Under Rule 116 dated April 18, 2005
Reply to Office Action mailed March 16, 2005

Atty. Docket No. CWD-026746-US-P1

REMARKS

Claims 1-47 are pending in the application. Claims 1-43 have been allowed. Independent claim 44 (as amended) is objected to under 35 U.S.C. § 132 on the ground that it introduces new matter. Claim 44 also stands rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent No. 4,032,030 to Bass ("Bass") in view of U.S. Patent No. 5,877,450 to Quin ("Quin"). Claims 45-47 are objected to as being dependent upon a rejected base claim. The specification is objected to under 37 CFR § 1.75(d)(1) and MPEP § 608.01(o) as failing to provide an adequate basis for the amendment of claim 44. Applicants respectfully request reconsideration of the rejections in view of the above amendments and the following remarks.

I. AMENDMENTS TO THE SPECIFICATION

The paragraph running from page 16, line 16 to page 17, line 4 has been amended to make it clear that: "The cover plate 140 (see, FIG. 13) is a generally planar substrate...." Support for this amendment is provided by FIG. 13, which clearly shows a cover plate 140 which is a generally planar "substrate". No new matter is added by this amendment because what is shown in the drawings can be added to the disclosure and does not constitute "new matter". *In re Wolfensperger*, 133 USPQ 537, 542 (CCPA 1962) ("The practical legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit new matter...for the simple reason *that* what is originally disclosed cannot be 'new matter' within the meaning of this law.")

Further, the drawings themselves form part of the disclosure. MPEP § 608.04 ("In establishing a disclosure, applicant may rely not only on the specification and drawing as

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filed....") See also, MPEP § 2163, at II.A.3, citing, *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 ("drawings alone may provide a 'written description' of an invention as required by Sec. 112...."); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Cl. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.")

The paragraph running from page 19, line 23 to page 20, line 8 has been amended to add the words "arcuate cut-out section". Also, since drawings form part of the disclosure (*supra*), support for the foregoing amendment can be found in FIG.13 which shows a concave shaped recess or arcuate cut-out section 80 disposed on a top corner of a cover plate and a concave shaped recess or arcuate cut-out section 84 disposed on a bottom corner of the cover plate. As used herein, the term "arcuate" is defined as "bent or curved in the form of a bow" *Webster's Third New International Dictionary, Unabridged*. Merriam-Webster, (2002). available at <<http://unabridged.merriam-webster.com>> (February 24, 2005). Based on this definition, the term "arcuate cut-out section" is synonymous with the term "concave shaped recess". The foregoing amendment does not add new matter because it merely clarifies what is meant by term "concave shaped recess" and the meaning of the amended paragraph remains the same. MPEP § 2163.03, at Part I. ("Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter.")

The amendment of the foregoing two paragraphs in the specification serves the purpose of providing support for amendment of claim 44 (filed on March 2, 2005) and is in

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accordance with the provisions of MPEP § 608.01(o). ("While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. x x x If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.")

Based on the foregoing, Applicants respectfully submit that the objection to the specification must be withdrawn.

II. NEW MATTER OBJECTION

The Examiner objected to the amendment of claim 44 on the ground that the following added material (shown as underscored) is not supported by the original disclosure:

a generally rectangular substrate having a generally planar surface, wherein a top corner of the substrate is cut away to form a first arcuate cut-out section and further, wherein a bottom corner of the substrate diagonally opposite from the first arcuate cut-out section is cut away to form a second arcuate cut-out section;

a first horizontally elongated mounting hole horizontally disposed on the substrate at a point adjacent to an opposite top corner of the substrate; and

a second horizontally elongated mounting hole horizontally disposed on the substrate at a point adjacent to an opposite bottom corner of the substrate.

Applicants respectfully disagree.

It is well settled that the drawings and specification may be used to support a claim amendment. See: MPEP 608.04; *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118; *Autogiro*

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Co. of America v. United States, 384 F.2d 391, 398, 155 USPQ 697, 703 (Cl. Cl. 1967). See also, *In re Wolfensperger*, 133 USPQ 537, 542 (CCPA 1962) ("If the drawing, then, contains the necessary disclosure, it *can* 'form the basis of a valid claim'."). Here, as seen in the table below, the written specification and the drawings supply ample support for the amendment to claim 44.

CLAIM 44 AMENDMENT	SUPPORT
<u>a generally rectangular substrate having a generally planar surface</u>	<p>Specification, page 16 at lines 21 <i>et seq.</i>, (as amended) – "The cover plate 140 (see, FIG. 13) is <u>a generally planar substrate</u> and has a set of removable ribs."</p> <p>FIG. 13 – shows a cover plate 140 that is a substrate having a generally rectangular shape and a generally planar surface.</p>
<u>wherein a top corner of the substrate is cut away to form a first arcuate cut-out section and further, wherein a bottom corner of the substrate diagonally opposite from the first arcuate cut-out section is cut away to form a second arcuate cut-out section</u>	<p>Specification, page 19, line 23 <i>et seq.</i> (as amended) – "In a preferred embodiment of the present invention (see, FIG. 13), the cover plate has [[a]] <u>an upper concave shaped upper recess or arcuate cut-out section 80</u> disposed on one top corner, ... a lower concave shaped recess <u>or arcuate cut-out section 84</u> disposed on a bottom corner diagonally opposite from the upper corner where the upper recess 80 is disposed...."</p> <p>FIG. 13 – shows elements 80 and 84 which are concave shaped recess or arcuate cut-out sections that are respectively disposed on diagonally opposite top and bottom corners of a substrate (i.e., cover plate 180).</p>

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CLAIM 44 AMENDMENT	SUPPORT
<p>a first horizontally elongated mounting hole <u>horizontally</u> disposed on <u>the substrate</u> at a <u>point adjacent</u> to an opposite top corner <u>of the substrate</u></p> <p>a second horizontally elongated mounting hole <u>horizontally</u> disposed on <u>the substrate</u> at a <u>point adjacent</u> to an opposite bottom corner of the substrate</p>	<p>Specification, at page 19, line 23 <i>et seq.</i> (as amended) -- "In a preferred embodiment of the present invention (see, FIG. 13), the cover plate has ... a first horizontally elongated mounting hole 82 disposed on an opposite top corner ... and a second horizontally elongated mounting hole 86 disposed on an opposite bottom corner."</p> <p>FIG. 13 -- shows element 82 (a horizontally elongated hole) that is horizontally disposed on a substrate (i.e., element 140) at a point adjacent* to an opposite top corner of the substrate and element 84 (a horizontally elongated hole) that is horizontally disposed on the substrate at a point adjacent* to an opposite bottom corner of the substrate diagonally opposite from the opposite top corner.</p> <p>*As used herein, the term "adjacent" means "not distant or far off; nearby but not touching" <i>Webster's Third New International Dictionary, Unabridged</i>, Merriam-Webster, 2002 <http://unabridged.merriam-webster.com> (April 5, 2005)</p>

Based on the foregoing, the specification and drawings clearly disclose the limitations recited in claim 44 as amended. Applicants therefore submit that the objection to the claim amendment must be withdrawn.

III. OBVIOUSNESS REJECTION

The Examiner also rejected claim 44 as being rendered obvious by *Bass* in view of *Quin*. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

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'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)" MPEP § 2143.03. See also: MPEP. § 2143 ("[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.) The references cited by the Examiner fail to meet this requirement.

First, *Bass* does not teach or suggest a cover plate suitable for use with a weatherproof electrical enclosure as recited in claim 44. Instead, *Bass* discloses cover element 31 for closing a square-shaped utility outlet box or (after breaking off the corners of the cover element) for closing an octagonal-shaped or round-shaped utility outlet box. See: *Bass*; at Abstract; col. 1, lines 39-64; col. 5, lines 3-12; and FIGS. 1-2, 5-6.

As Applicants have repeatedly explained in their responses to previous office actions, the term "cover plate" relates to plates generally used in the electrical industry for covering electrical fixtures, such as receptacles and switches in order to prevent inadvertent access to the electrically conductive parts of electrical fixtures and to conceal the wiring thereof. Specification at page 16, line 16-19. The term "weatherproof electrical enclosure" refers to enclosures for protecting electrical fixtures, such as receptacles and switches, against the effects of the elements (e.g., rain, moisture, and dust). Typically, such enclosures comprise a generally boxed-shaped base that is sized to receive an electrical fixture, and a cover pivotably attached to the base. Specification at page 1, line 15-18. When the cover plate of claim 44 is in actual use, the cover plate is positioned inside the base of the enclosure (see, e.g., cover plate 140 in FIG. 1) so as to prevent inadvertent access to the electrically conductive parts of the electrical fixture and to conceal the wiring thereof (*supra*).

Second, *Bass* does not teach or suggest arcuate cut-out sections as recited in claim 44. As discussed previously, these "arcuate cut-out sections" make it easier to install, position and

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remove the cover plate from within the base of an enclosure. (See, specification at page 3, line 14-18 and page 20, line 6-8.) Instead, *Bass* discloses narrow slots 34 that are cut into the surface of the cover element 31. (*Bass*, col. 3, lines 31-52, FIG. 3) Further, in contrast to arcuate cut-out sections, the purpose of these slots 34 is to make it easier to knock or break off the corner portions 32, 35 of the cover element 31 so that the square-shaped cover element 31 can be modified for closing octagonally-shaped utility outlet boxes (*Bass*, col. 3, lines 31-67; FIG. 6) or round-shaped utility outlet boxes (*Bass*, col. 5, lines 3-12).

Third, *Bass* does not teach or suggest horizontally elongated mounting holes that are horizontally disposed on the substrate at points respectively adjacent to opposite top and bottom corner of the substrate as recited in claim 44. Instead, *Bass* discloses a keyhole shaped area 37 and a U-shaped area 38 that are diagonally disposed on the cover element 31. (*Bass*, col. 3, lines 53-59).

Fourth, *Bass* does not disclose first and second mounting holes respectively disposed at points adjacent to opposite top and bottom corners of a substrate. However, the Examiner states that it would have been obvious to modify *Bass* because rearranging the parts of an invention involves only routine skill in the art. Applicants respectfully disagree.

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." (MPEP § 2144.04, at Section VI, Part C) The Examiner has cited no such motivation for modifying *Bass*.

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Also, the Examiner cites *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the proposition that rearrangement of the parts of an invention only involves routine skill in the art. However, *Japikse* does not support this broad proposition. In *Japikse*, the Court held that "there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified." 86 USPQ at page 73. In contrast, as previously discussed above, the horizontal positioning of the mounting holes on diagonally opposing top and bottom corners of the substrate provides a useful result different from prior art positioning -- i.e., the chosen positioning allows the mounting holes to coact with the arcuate cut-out sections so as to facilitate the easy insertion, positioning, and removal of a cover plate from within an enclosure -- and thus represents more than mere arbitrary rearrangement of parts.

The *Quin* patent does not overcome the deficiencies of the *Bass* patent. According to the Examiner, *Quin* teaches the use of a cover plate that is a generally rectangular substrate. Applicants respectfully disagree. The disclosure of the *Quin* patent is limited to a lid 32 attached by hinges 39 to a box 12. See, *Quinn* at col. 4, lines 57-61 and FIG. 1.

In order "[t]o establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." (MPEP § 2143) The Examiner has cited no such suggestion or motivation for combining *Bass* and *Quin*. More fundamentally, however, the Examiner's proposed combination does not yield the invention recited in claim 44.

Based on the foregoing, the *Bass* and *Quin* references, whether taken individually or in combination, fail to render claim 44 obvious. Applicants therefore submit that the rejection of claim 44 must be withdrawn.

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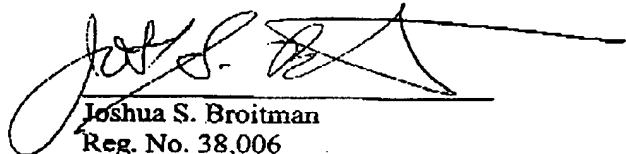
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The Examiner also objected to the drawings under 37 CFR 1.83(a) on the ground that the first and second arcuate sections recited in amended claim 44 are not shown. In response, Applicants refer to their arguments above with respect to the arcuate cut-out sections and also direct Examiner's attention to elements 80 and 84 in FIGS. 13 and 13A-13C, which respectively show first and second arcuate cut-out sections as recited in claim 44 as amended.

For the reasons set forth above, Applicants believe that claim 44 is allowable. Claims 45-47 depend from claim 44 and are therefore allowable for the same reasons as claim 44. Thus, Applicants request that this case be passed to issue. However, if any issue remains to be resolved, Applicants request that the Examiner telephone the undersigned.

Respectfully submitted,

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